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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,569	12/21/1999	WOLFGANG WEIDNER	826	4514

7590 03/15/2002

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HUNTINGTON, NY 11743

EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/367,569

Applicant(s)

WEIDNER ET AL.

Examiner

Marcos L Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 1999.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on December 21, 2001 have been fully considered but they are not persuasive.

The applicant discloses a first and second operating mode in a mobile phone. For the examination of this application we understand as operating mode: instructions designed to control the hardware of a specific data-processing system in order to allow users to employ it easily. Tsoi teachings disclose a user interface that controls the functions of the mobile phone with different modes for controlling several options. Tsoi discloses in fig. 7 a first operating mode and a second operating mode in fig. 9 and as presented in previous office action. Simple difference in naming or calling of an element is not sufficient basis for establishing patentability.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9,12,14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsoi.

As to claim 9, Tsoi discloses a radio apparatus embodied in a radiotelephone comprising a display device; at least one control element for selecting and/or activating functions of the radio apparatus which are displayed on said display device, column 6,

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lines 40-43; said at least one control element being disposed neighboring said display device so that a local association exists between said at least one control element and displaying of functions of the radio apparatus on said display device, column 2, lines 50-53; means for providing at least one first operating mode in which information about said first operating mode is associated in said display device with at said at least one control element, column 6, lines 62-65, and information in a second operating mode associated with said first operating mode is converted into a function for activating said first activating mode, which function is activate able by said at least one control element, column 7, lines 1-6.

As to claim 12, Tsoi discloses a radio apparatus comprising a housing provided for the radio apparatus and having an upper surface, said display device being rectangular and disposed on said upper surface of said housing, said at least one control element being disposed on at least one side of said display device, column 5, lines 42-47 and figure 5.

As to claim 14, Tsoi discloses a radio apparatus that have at least one control element is formed so that through said at least one control element sub items in an operating manual can be selected and/or activated, column 7, lines 14-17.

As to claim 15, Tsoi discloses a radio apparatus that have at least one control element is formed so that through said at least one control element entries in a telephone number dispose in a radio apparatus are selectable, column 7, lines 18-22.

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As to claims 16 and 17, Tsoi discloses a radio apparatus comprising a control field in which said at least one control element is located and the control field is formed as an alpha numeric keyboard, column 7, lines 29-34 and figure 12.

As to claim 18, Tsoi discloses a radio apparatus comprising a housing provided for the radio apparatus and having an upper surface, said at least one control element being disposed neighboring the peripheral region of said upper surface of said housing, column 5, lines 42-47 and figure 5.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsoi in view of Mills.

As to claims 9-10, Tsoi discloses everything claimed as explained above except for an apparatus wherein between said at least one control element and the displaying of the associated functions of the apparatus on said display device, graphic symbols are displayable on said display device as a shape of arrow. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine this technique to the device of Tsoi in a mobile telephone, for the simple purpose of insuring that the user associated each control elements to it's proper graphic symbol.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsoi in view Bowen.

As to claim 13, Tsoi discloses everything claimed as explained above except an apparatus wherein said at least one control element is light able. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine this lighting technique to the device of Tsoi in a mobile telephone, for the simple purpose of allowing the user the keys to be view in low light areas.

### ***Conclusion***

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**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. friday. '

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-305-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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Marcos L Torres  
Examiner  
Art Unit 2683

Mlt  
March 11, 2002

A handwritten signature in black ink, appearing to read 'W-Trost'.

WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600